

REMARKS

Claims 1-71 are currently pending in the application. Applicants have amended claims 1-2, 9, 12, 25, 28-29, 33-37, 43, 46-47, 49, 52-55, 59, and 63-66 and add claims 67-71. Applicants request reconsideration of the application in light of the following remarks.

Objections to the Specification

The specification has been objected to for containing informalities. Applicants have amended the specification to address the Examiner's concerns by shortening the length of the Abstract of the Disclosure to less than 150 words. Applicants respectfully request that the Examiner withdraw the objection to the specification.

Objections to Claims

The Examiner has objected to claims 2-8, 10, 38, 54 and 55 for being dependent upon a rejected base claim. Applicants have amended claim 2 as suggested by the Examiner, to place claim 2 in independent form including all the limitations of original claim 1. Therefore, the objection of claims 2-8 have been overcome and Applicants request a notice of allowance for these claims. Similarly, claims 54 and 55 have been placed in independent form and have been amended to include details from a base claim. The original matter of claims 54 and 55 that was indicated by the Examiner as being patentable, together with these details is considered to similarly define over the art. Therefore, Applicants request a withdrawal of the objections to claims 54 and 55, and an indication of allowance of the same. Claims 9 and 37, (from which patentable claims 10 and 38 depend, respectively), have been amended to define over the art relied upon. Therefore, claims 9-10 and 37-38 are considered to be allowable, and a notice of allowability of these claims is respectfully requested. Applicants respectfully request that the objections to claims 2-8, 10, 38, 54 and 55 be withdrawn and that claims 2-10, 37-38, 54 and 55 be allowed.

Rejections under 35 U.S.C. §112

Claims 33 and 34 stand rejected by the Examiner under 35 U.S.C. 112. In accordance with this rejection, the claims have been amended to comply with the examiner's suggestions and are now believed to conform with Section 112. Applicants respectfully request that the rejection of claims 33 and 34 under 35 U.S.C. § 112 be withdrawn.

Double Patenting Rejection

Claims 1, 13-25, 28, 35 and 36 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending U.S. Application No. 10/434,553. In order to avoid further expenses and time delay, Applicants elect to expedite the prosecution of the present application by filing a terminal disclaimer to obviate the double patenting rejections in compliance with 37 CFR §1.321 (b) and (c). Applicants' filing of the terminal disclaimer should not be construed as acquiescence of the Examiner's double patenting or obviousness-type double patenting rejections. Attached is the terminal disclaimer and accompanying fee.

Claims 9, 11, 26, 28, 29-34, and 49-53 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending U.S. Application No. 10/434,553 in view of Owens. In order to avoid further expenses and time delay, Applicants elect to expedite the prosecution of the present application by filing a terminal disclaimer to obviate the double patenting rejections in compliance with 37 CFR §1.321 (b) and (c). Applicants' filing of the terminal disclaimer should not be construed as acquiescence of the Examiner's double patenting or obviousness-type double patenting rejections. Attached is the terminal disclaimer and accompanying fee.

Rejections under 35 U.S.C. §102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 1, 9, 11, 12, 25-28, and 37 were rejected under 35 U.S.C. § 102(e) as being anticipated by Ryan (U.S. Patent No. 6,406,387, hereinafter “Ryan”). Applicants respectfully traverse this rejection and request reconsideration of the claims.

Applicants have amended claim 1 to include details to the transition piece that are not provided by Ryan. Specifically, claim 1 has been amended to include that “the transition piece forms a smooth, generally continuous radially outwardly facing surface together with at least a portion of the barrel”. Ryan’s bat does not have this structural detail. The element 22, which the Examiner refers to as a transition, does not form a continuous radially outwardly facing surface together with the barrel 4. Rather element 22 forms a discontinuous surface that faces axially. Therefore, claim 1 is considered to be allowable over Ryan.

Claim 9 has been placed in independent form and further amended to recite that the “ballast [is] supported on the end cap and the transition piece”. The Examiner refers to “the ring around the top of the tube at the top of the barrel” as a ballast. As such it is clear that Ryan does not have a ballast supported on both of the end cap and the transition piece as now recited in claim 9. Therefore, claim 9 is considered to be allowable over Ryan.

Claim 25 has been placed in independent form and amended to more precisely recite a limitation that is considered to define over the prior art. Specifically, claim 25 now recites that each of “the end cap and the transition piece have respective bearing surfaces each with the same minimum diameter”. Ryan does not have this limitation since the barrel bears on the so-called transition piece 22 at a diameter that is smaller than that at which the barrel bears on the end cap 2, as can be seen in Figure 1 of Ryan. Furthermore, claim 25 includes

the recitation of: “the barrel is a straight cylindrical barrel and engages each of the end cap and the transition piece at the minimum diameter”. This recitation also defines over Ryan since Ryan’s barrel 4 is not a straight cylinder, but rather has a tapered portion at a proximal end thereof. Furthermore, the barrel 4 of Ryan bears on the so-called transition piece 22 at a diameter smaller than the bearing surface between the barrel 4 and the end cap 2. Hence, claim 25 is patentable over Ryan. Withdrawal of the rejection of claim 25 and allowance thereof is earnestly solicited.

Claim 28 has been placed in independent form and amended to more precisely define the abutting structure that mounts the barrel assembly on the center tube in order to define over Ryan’s device. In particular, claim 28 now recites that “the barrel assembly is axially abutted at a distal end and axially abutted at a proximal end by structure on the center tube to clamp and hold the barrel assembly in position on the center tube”. Ryan fails to provide this limitation since the barrel 4 of Ryan is fastened to the center tube 6 by a screw 20 that engages radially through the barrel 4, the so-called transition piece 22, and a wall of the center tube 6. Furthermore, in order for the barrel, end cap, and so-called transition piece to form a barrel assembly, the screw 20 must be included in the barrel assembly. Otherwise, the components will not stay together and form the assembly. As such, there is no structure on the center tube 6 of Ryan for axially abutting the “barrel assembly” at a proximal end of the barrel assembly. Therefore, claim 28 defines over Ryan. Withdrawal of the rejection of claim 28 and allowance thereof are respectfully requested.

Claim 37 has been placed in independent form and amended to define over the reference to Ryan. In particular, claim 37 is directed to a reconfigurable ball bat having a transition piece that is made up of two connectable parts in accordance with the embodiments shown in Figures 9H-10C. As shown, and now claimed, “the transition piece comprises two connectable concentric parts”. Ryan fails to provide the two connectable parts 20 and 22 as “concentric”. Furthermore, the Examiner has construed the screw 20 to be part of the so-called transition piece, which is contrary to the commonly known meaning of the term transition as it relates to bats. Therefore, claim 37 is considered to be allowable over Ryan. Withdrawal of the rejection of claim 37 and allowance thereof is earnestly requested.

Claims 11-12 and 26-27 are considered to be allowable as depending from allowable base claims and for further patentable details therein as may be appreciated by the Examiner. As such, Applicants respectfully request that the anticipation rejections of claims 1, 9, 11-12, and 26-27 be withdrawn and that these claims be allowed.

Rejections under 35 U.S.C. §103

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based upon the Applicants' disclosure. A failure to meet any one of these criteria is a failure to establish a *prima facie* case of obviousness. MPEP §2143.

Claims

Claims 13-21, 23, and 24 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Ryan (U.S. Patent No. 6,406,387, hereinafter "Ryan"). Applicants respectfully traverse this rejection and request reconsideration of the claims.

Claims 13-21, 23, and 24 are considered to be allowable as now depending from an allowable base claim 1, and for further details therein as may be appreciated by the Examiner.

Claims 29-34 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Ryan (U.S. Patent No. 6,406,387, hereinafter "Ryan"), in view of Owen et al. (U.S. Patent No. 3,116,926, hereinafter "Owen"). Applicants respectfully traverse this rejection and request reconsideration of the claims.

Claim 29 has been placed in independent form and is considered to be allowable for reasons that may not have been appreciated before by the Examiner. In particular, claim 29 recites that the barrel assembly comprises “a ballast disposed within the barrel” and that “the ballast is a non-strengthening member”. The Examiner has held that the ballast of Ryan is “the ring around the top of the tube at the top of the barrel” of Ryan. The ring around the top of the tube at the top of the barrel of Ryan is referred to as a bushing in Ryan’s disclosure and is a **strengthening** member. Therefore, the ballast must be supplied by the secondary reference to Owen. However, it is not clear how the weights 15 of Owen could be applied to the bat of Ryan without destroying the primary reference to Ryan. In order to place the weights 15 of Owen inside the barrel of Ryan, the center tube 6 of Ryan would have to be removed. This would disconnect the end cap of Ryan from the rest of the bat.

Claim 29 also recites that the “non-strengthening member” is “for adding a predetermined weight so that the reconfigurable ball bat weighs less than or equal to 30 ounces”. In this regard, it is to be noted that the bat of Ryan is made of several heavy materials including a center tube of tubular stainless steel, solid fiberglass, solid aluminum, a slidable handle with a brass tube or rigid plastic tube 8, a rubber or rubberlike grip 10, and a non-slidable handle of aluminum and rubber, as set forth in column 2, lines 25-45. The handles also have molded in finger grip locators 112. The practice bat of Ryan constructed of these materials will weigh substantially more than 32 ounces. Furthermore, the barrel 4, end cap 2, bushing 116, and collar 22 also appear to be made of metal which would further contribute to high weight. This is significant in today’s game because bats of weights greater than 30 ounces are simply not competitive. Therefore, even if weights over 30 ounces are acceptable for practice bats like that of Ryan, they are not acceptable for competitive play. Applicants hold that the combination of Owen with Ryan would destroy the reference of Ryan as set forth above. On the other hand, addition of even one of the weights 15 of Owen would further cause the practice bat of Ryan to weigh well in excess of the claimed maximum of 30 ounces. Therefore, neither Ryan nor Ryan and Owen meet the weight limitation of Claim 29. Conversely, present invention advantageously provides a playing bat including a center tube, barrel assembly, and a ballast, which together weigh

“less than or equal to 30 ounces” as claimed. Therefore, claim 29 clearly distinguishes over Ryan and Owen, and allowance of claim 29 is earnestly solicited.

Claims 30-34 are considered to be allowable as depending from an allowable base claim 29 and for further patentable details therein as may be appreciated by the Examiner. Therefore, withdrawal of the rejection of claims 29-34 is respectfully requested.

Claims 35, 36, and 49-52 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Ryan (U.S. Patent No. 6,406,387, hereinafter “Ryan”), in view of Muhlhausen (U.S. Patent No. 6,050,908, hereinafter “Muhlhausen”). Applicants respectfully traverse this rejection and request reconsideration of the claims.

Claim 35 has been placed in independent form and is considered to be allowable for reasons perhaps not fully appreciated by the Examiner previously. Claim 35 has a “plurality of barrel assemblies that are selectively and removably mounted on the center tube” for the purpose of providing a reconfigurable ball bat. While Ryan and Mulhausen are both directed to batting practice devices, they have completely different specific purposes provided by completely different incompatible structures. These incompatibilities among other things provide good reasons not to combine Mulhausen with Ryan, as set forth below.

Firstly, Ryan’s practice bat was never intended for reconfiguration or dismantling. Therefore, applying a teaching of dismantling for the purpose of reconfiguration raises the question of whether doing so will cause damage or yield substandard function of the practice bat of Ryan.

Secondly, Mulhausen lacks a barrel with which to modify Ryan’s device. Rather Mulhausen has an elongate contact surface 30 that is intentionally made to have a small diameter to require improved skill in striking a ball as set forth in the Abstract of the disclosure and column 4, lines 39-43. This contact surface cannot properly be construed as a barrel since doing so would require reference to element 30 by a term “barrel” outside its customary meaning in the art in which it is applied. That is, the term “barrel” is known by those of ordinary skill in the art to refer to the portion of a bat that is substantially larger than the handle portion and that is located distally from the handle portion in a traditional bat

configuration. Mulhausen apparently understood this and did not refer to the contact surface 30 as a “barrel”. The Examiner may not properly consider the contact surface 30 of Mulhausen to be a barrel either. Therefore, “replaceable barrels” are not disclosed by Mulhausen, and the reference to Mulhausen is thus not properly combinable with Ryan to meet the claim of “a plurality of barrel assemblies that are selectively and removably mounted on the center tube”. Furthermore, Mulhausen does not have a center tube on which to teach mounting of a variety of contact surfaces let alone barrel assemblies.

Thirdly, it is not clear, from Ryan and Mulhausen, how one could modify the reference to Ryan in accordance with the teachings of Mulhausen without destroying Ryan’s device. For example, in order to provide an opening like opening 25 of Mulhausen for receiving a variety of contact surfaces 30, the center tube 6 of Ryan would have to be removed, which would render Ryan’s device inoperable.

Fourthly, even if, **(in light of Mulhausen)**, a way were discovered to provide a “plurality of barrel assemblies that are selectively and removably mounted on the center tube” of Ryan, the teachings of Mulhausen do not provide such reconfigurability by a “plurality of barrel assemblies” as defined by claim 35. That is, the barrel assemblies must have an end cap, a barrel, and a transition piece removably supported on the center tube by the transition piece and the end cap. Since Mulhausen does not have an end cap and a transition piece supporting the removable contact surface 30 on a center tube, Mulhausen cannot properly provide a teaching that would enable one of ordinary skill to provide anything removably mounted by an end cap and a transition piece on a center tube for the purpose of reconfiguring a bat. Such structure and its directly related function can only be arrived at by improper hindsight in light of the present invention.

Therefore, withdrawal of the rejection of claim 35 and allowance thereof is earnestly requested.

Claim 36 is considered to be allowable as depending from an allowable base claim and for further details therein as may be appreciated by the Examiner.

Claim 49 has been amended to focus on “selecting the barrel assembly in accordance with a desired playability”, which is clearly not provided by Ryan. Claim 49 also recites the details of the barrel assembly including the transition piece, the end cap, and the barrel removably mounted on the center tube. Hence, the arguments against the combination of Mulhausen with Ryan set forth above apply as well to the rejection of claim 49. Therefore, withdrawal of the rejection of claim 49 and allowance thereof are respectfully requested.

Claims 50-51 are considered to be allowable as depending from an allowable base claim and for further details therein as may be appreciated by the Examiner.

Claim 52 has been placed in independent form and is considered to be allowable on its own merits. In particular, claim 52 includes the step of “selecting the barrel assembly in accordance with a desired weight and/or playability”, which is clearly not provided by Ryan. Claim 52 also recites the step of “supporting the barrel assembly on the center tube”, which is an assembly step that is not disclosed by Ryan and Mulhausen separately or in combination. Like claims 49 and 35, claim 52 also has the details of the barrel assembly including the transition piece, the end cap, and the barrel removably mounted on the center tube. Hence, the arguments against the combination of Mulhausen with Ryan set forth above apply as well to the rejection of claim 52. Therefore, withdrawal of the rejection of claim 52 and allowance thereof are respectfully requested.

New Claims

Claims 67-68 have been added to present the limitation of different playability characteristics separately from weight characteristics with which it was previously presented in the alternative.

Claim 69 is presented to obtain separate coverage of the center tube of the present invention.

Claim 70 is presented to obtain coverage for the unique step of inserting the center tube knob end first through the barrel assembly.

Claim 71 is similar to claim 56 with the exception of the step of supporting so as to remove the limitation of supporting the barrel assembly on the center tube for broader coverage to which Applicants are entitled.

Indication of Allowable Subject Matter

The Examiner objected to claims 2-8, 10, 38, 54 and 55 as being dependent upon a rejected base claim, but indicated these claims would be allowable if corrected and all the claims were rewritten in independent form. Applicants wish to thank the Examiner for this indication of allowable subject matter. Claims 2-8, 10, 38, 54 and 55 have been amended herein to incorporate the elements of the respective base claims upon which they depend as described in the section regarding claims objections above. These claims are therefore considered to be allowable.

Confirmation of Allowed Claims

Applicants wish to thank the Examiner for his confirmation of the patentable subject matter of claims 39-48 and 56-66. The Examiner has also indicated that claim 53 would be allowable upon filing a terminal disclaimer, which is included herewith. Applicants have placed claim 47 in independent form since claim 47 appears to be patentable on its own merits together with some base claim recitation. Likewise, claims 59, 63, 64, 65, and 66 have been placed in independent form, each considered as having patentable subject matter. Therefore, Applicants accept the indication of allowance of claims 39-46, 56-58, and 60-62 as indicated by the Examiner, and has further amended claims 47-48, 59, and 63-66 into independent form to provide patentability for reasons other than those indicated by the Examiner. Nevertheless, claims 39-48, 53, and 56-66 are considered to be allowable and notice thereof is earnestly solicited.

Regarding Doctrine of Equivalents

Applicants hereby declare that any amendments herein that are not specifically made for the purpose of patentability are made for other purposes, such as clarification, and that no such changes shall be construed as limiting the scope of the claims or the application of the Doctrine of Equivalents.

CONCLUSION


Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

The amendments herein added 20 new independent and 2 new dependent claims, resulting in fees due of \$905.00. A check in the amount of \$905.00 has been included herewith to pay for the extra claims the extension fee.

If any fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 19-0513. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response. The examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

Date: June 24, 2004

By 
David E. Allred
Reg. No. 47,254

SCHMEISER, OLSEN & WATTS LLP
18 East University Drive, #101
Mesa, AZ 85201
(480) 655-0073